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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,658	07/16/2003	Arno Schmuck	07244-00141-US	1458
23416	7590	05/19/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,658	<b>Applicant(s)</b> SCHMUCK ET AL.	
	<b>Examiner</b> EDWYN LABAZE	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 2/28/2005.
2. Claims 1-16 are presented for examination.

### *Priority*

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 and 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Haghiri et al. (U.S. 5,888,624).

Re claim 1: Haghiri et al. discloses data carrier [a paper IC card 3] with an electronic module 1 {as shown in fig. # 1} and a method for producing the same, which includes in that an image [as broadly claimed and interpreted by the examiner, Shimada discloses means of providing a sheet with a printed image {represented as a reference 2 in fig. # 1} before punching (col.8, lines 11+; col.9, lines 33+; col.10, lines 43+)] is arranged on at least one main surface of the paper core/base [as shown in figs. # 7-8; wherein the structure of the card bodies 3 consisting of exclusively of paper and cardboard], at least 5% [i.e. a portion up to the entire surface] of at least one main surface are covered by a seal and the chip1 is covered on both main surfaces with a seal or a plastics layer [during lamination] (see col.6, lines 25+; col.10, lines 2+).

Re claims 2-3: Haghiri et al. teaches an apparatus and method, wherein at least one seal consists of plastics or a plastics-coated paper [also known in the art as “laminating technique” and used as a cover layer. Herein and incorporated in the specs, Haghiri et al. teaches a cover layer 9 {and other references such as EP-B1 0 140 230, EP-A1 0 493 738} and method wherein the card body consisting of plastic layer through the laminating technique; col.1, lines 10+; col.2, lines 4+; col.3, lines 60+). Furthermore, Haghiri et al. teaches means of coating the layers using a silicone band 29 (col.5, lines 1+; col.8, lines 9+; col.10, lines 44+).

Re claims 4-5: Haghiri et al. discloses an apparatus and method, wherein the paper core comprises at least one image-receiving [herein Haghiri et al. discloses markings on the surface of the card, which could be in the form of an image] layer on at least one main surface and the image-receiving layer comprises a microporous or gelatine-containing layer (col.9, lines 33-67).

Re claims 9-11: Haghiri et al. teaches an apparatus and method, that it is provided on at least one main surface with a seal which is at least 5% smaller than the main surface, wherein the seal extends at no point to the edge of the card 3, and the seal covers the recess [herein as a two-step gap 15/19 as shown in figs. # 3-4, 12, 6] for the chip or electronic module 1 on at least one side (as shown in fig. # 18; col.8, lines 60-67; col.9, lines 1+).

Re claims 12-13: Haghiri et al. teaches an apparatus and method, wherein the paper core contains at least one recess [herein as a two-step gap 15/19 as shown in figs. # 3-4, 12, 6] with fine structures to accommodate the chip 1 (col.4, lines 50+).

Re claims 14-15: Haghiri et al. discloses an apparatus and method, wherein the covered on at least one main surface at least over its entire area with a plastics layer [using the laminating technique through thermal roll {as shown in figs. # 4 & 12} or punch out of the edges {as seen in

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fig. # 18}, which projects beyond all the card's edges and the projecting margins of the two layers are welded [as seen in fig. # 18] together (col.2, lines 5-20; col.4, lines 10+; col.8, lines 61-67; col.9, lines 1+).

Re claim 16: Haghiri et al. teaches an apparatus and method, comprising an image is produced on the paper core, a recess for the chip is then created, the chip or electronic module 1 is inserted once the recess [herein as a two-step gap 15/19 as shown in figs. # 4, 12, 6, 17c] has been covered on one side with the seal {such as adhesive layers 5, 21} and then the second side of the recess is covered with the seal {such as adhesive layers 9, 23} or a plastics layer (col.4, lines 40-67).

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haghiri et al. (U.S. 5,888,624) in view of Fraser et al. (U.S. 4,855,583).

The teachings of Haghiri et al. have been discussed above.

Haghiri et al. fails to teach an image-forming layer comprising a photographic layer.

Fraser et al. discloses structure and method of making combination proximity/insertion identification cards, which includes an image-forming layer 434 comprising a photographic layer (as shown in fig. # 4 of Fraser et al.; col.5, lines 65+; col.7, lines 32+; col.10, lines 15+).

In view of Fraser et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Haghiri et al. an image-forming layer comprising a photographic layer so as to authenticate the image of the cardholder. Furthermore, such modification is well known in the art [as exemplified by the examiner in U.S. reference 5,410,642 of Hakamatsuka et al.; see figs. # 3-5, 13, 16, 18] and would provide adequate security of the card render very visible any falsification/tampering of the image/photograph on the card. Moreover, such modification would have been an obvious extension as taught by Haghiri et al., therefore an obvious expedient.

#### *Response to Arguments*

8. Applicant's arguments filed on 2/28/2005 have been fully considered but they are not persuasive.

The applicant argues that the prior art of record, Haghiri et al. (U.S. 5,88,624), fails to disclose or suggest covering the chip on both sides with a seal or a plastic layer (see page 5, lines 19+; page 7, lines 8+ of applicant's arguments).

The examiner respectfully disagrees with the applicant's remarks. Haghiri et al. does teach that the electronic module 1 is inserted in window 15 and covered of two layers 9 and 5 (as shown in figs. # 4, 12; col.7, lines 1+).

The applicant also argues that, at column 9, lines 44 to 50 of Haghiri, a protective lacquer layer is disclosed for the external surfaces of the cover layers. Although there is no specific disclosure concerning the effect of this means, the protection would be interpreted by a person skilled in the art to be provided against environmental effects such as moisture. This is contrary to the objective of the present invention wherein the seal improves the anti-counterfeiting

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property of a paper based chip card (see page 6, lines 3+; and page 7, lines 3+ of applicant's arguments).

The examiner respectfully disagrees with the applicant's remarks because none of the claims of the claimed invention recite the limitations "wherein the seal improves the anti-counterfeit property of a paper based chip card.

The applicant argues that the claimed invention differs from the prior art with regards that the seal is at least 5% smaller than the main surface of the card (see page 6, lines 16+ of applicant's arguments).

The examiner agrees that the prior art does not teach such limitations. Nevertheless, Haghiri discloses that the layers are very thin (col.5, lines 34+). Therefore a range of at least 5 % smaller than the main surface could be herein broadly interpreted as being very thin compares to the core surface.

The applicant further argues that there is no hint to combine a plastic layer from the prior art with the paper of Haghiri. To the contrary, as noted above, Haghiri clearly teaches the use paper-only cards (see page 6, lines 22+; page 7, lines 1+ of applicant's arguments).

The examiner respectfully disagrees with the applicant's remarks for the following reasons. The applicant fails to respond why it would not be obvious to one skilled in the art to modify structure and method of making combination identification cards of Fraser into the system of Goetz. Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references {In re Nomiya, 184 USPQ 607

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(CCPA 1975)}. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art, {In re McLaughlin, 170 USPQ 209 (CCPA 1971)}, and wherein references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures {In re Bozek, 163 USPQ 545 (CCPA 1969)}. Therefore, the examiner retains the rejection as set forth in paper No. 11022004 and above.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hakamatsuka et al. (U.S. 5,410,642) discloses ID card issuing system.

Shimada (U.S. 6,002,383) teaches polymer dispersed liquid crystal film using heat or an electric field to change state and the other to change back.

Thompson et al. (U.S. 6,623,039) discloses multi-purpose card.

Jones et al. (U.S. 6,843,422) teaches contact smart cards having a document core, contactless smart cards including multi-layered structure, pet-based identification document, and methods of making same.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
May 6, 2005



**THIEN M. LE**  
**PRIMARY EXAMINER**